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Filing Date	03/29/2004
First Named Inventor	Joseph D. DAKAN, Sr.
Art Unit	1725
Examiner Name	Ing-Hour Lin
Attorney Docket Number	P 04-08

ENCLOSURES (Check all that apply)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Michael J. Weins
Signature	<i>Michael J. Weins</i>
Date	9/17/04

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Joseph D. DAKAN, Sr., et al.
Serial Number: 10/813,186
Filed: 03/29/2004
Attorney Docket No: P 04-08
Group Art Unit No: 1725
Examiner: Lin, Ing-Hour

For: METHOD FOR FABRICATING BOTTLE MOLDS

Lebanon, New Hampshire
September 17, 2004

Commissioner for Patents
Washington, DC 20231

S I R:

Request for Reconsideration in Response to Office Action

Applicants' attorney would like to make of record his request made by telephone on 08/30/2004 for clarification of the Examiner's office action dated 08/24/2004. Pursuant to the discussion, Applicants' attorney is responding to Point 3 in accordance with the Examiner's verbal statement that the remarks on Point 3 should refer to Claims 1 - 2 and 5 - 7, rather than Claims 15 -16, 18-23 and 25 - 26 which were referenced in his action.

In response to the office action of 08/24/2004 and the telephonic discussion with the Examiner on 08/30/2004, Applicants' representatives respectfully request reconsideration and allowance of the claims for the reasons set forth below.

With regard to the contention that Williamson, considered in view of Dakan, et al., makes the claimed method obvious, Applicants' representatives respectfully disagree. Williamson is directed to a cast mold and, while Williamson teaches limitations which must be placed on the

casting process suitable to produce the claimed mold, these limitations do not teach or suggest the method claimed in the present application. In fact, Williamson clearly points out the difficulty of making the claimed mold and teaches the controls that need to be followed regarding the flow of molten metal to avoid melting of the inserts (see column 2, lines 6 - 27). Even with these controls, Williamson teaches that the size of the insert must be carefully selected to avoid cracking or excessive melting of the insert (see column 2, lines 43-52). There is no suggestion in Williamson that there is a need for reduced shrinkage and/or refined grain size.

Dakan et al. teach the use of chill to refine grain structure; however, this teaching is for a copper base alloy used for glass container molds, not for cast iron. Not only is this teaching for a mold of a copper base alloy, but there is no teaching of the use of inserts which subsequently form part of the resulting cast bottle mold, as is employed in the present method to produce the cast mold that is claimed in allowed U.S. Application 09/788,746, of which the present application is a division. It should also be noted that, unlike Dakan et al., the Williamson molds had inserts cast therein.

In view of the differing teachings of the two cited patents by the Examiner, it is not felt that there is any motivation to combine the references. The Examiner appears to be using the teaching of the present invention as a road map for combining the cited art in a manner so as to provide the present invention; such is improper where there is no suggestion in the prior art of combining the claimed elements. The courts have found that there is a need for a teaching to combine the references to support an assertion of obviousness. *In re Fine* 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) maintained that the PTO can satisfy its burden to establish a *prima facie* case of obviousness quoting *In re Lahu*, 747 F.2d 703, 705; 223 USPQ 1257, 1258 (Fed Cir. 1984):

"... only by showing some objective teaching in the prior art or that knowledge generally

available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

In re Fine 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) also stated:

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

Furthermore, even if the references were combined as suggested by the Examiner, the resulting combination would still not make obvious the method set forth in the claims of the present application. The method of the present invention is further distinguished over the combination suggested by the Examiner in that there is no teaching in either Dakan et al. or Williamson of the claimed step of providing one or more insert imprints in the chill. See Paragraph [0012] of the specification for further discussion regarding the benefit of the method of the present invention, which overcomes the size limitations of the inserts set forth by Williamson. Such is not taught, disclosed, claimed or made obvious by the Williamson or Dakan et al. patents, or the combination of the two, and provides a surprising result in overcoming the size limitations taught by Williamson.

The Examiner may be using hindsight to modify the references to include the additional claimed step, which again is not permitted. The court in *In re Fritch* 23 USPQ 2d 1780 supported the position that the mere fact that the prior art may be modified to reflect the features of the claimed invention does not make the claimed invention obvious, unless the desirability of such modification is suggested in the prior art. The court in *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 220 USPQ 303, 312-313 (Fed. Cir. 1983) stated:

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."

With respect to claim 2, this claim explicitly requires the inserts to be formed of a nickel base alloy, a material which melts at a lower temperature than the cast iron, thus providing further benefit to the practice of the method of the present invention.

With respect to claims 5 - 7, the use of these configurations are of particular benefit due to more rapid solidification to assist in bonding the inserts in the cast iron.

With respect claims 3 and 4, which set forth limitations of the gating and risering system, Applicants are not simply claiming the use of a sprue, runner, riser, ingate, and riser neck, but rather a particular combination of these elements and their placement relative to the casting. This combination and configuration are not taught by the art cited by the Examiner. More specifically, Dakan et al. have no teaching of a sprue, runners, risers, ingates or riser necks; Williamson has no teaching of a sprue, runner or risers, and the ingates that Williamson does show would be inconsistent with the flow of metal which results from the practice of the claimed method as set forth in claims 3 and 4. While Jeanneret does teach a sprue, runner, riser, ingate, and riser neck, the invention of Jeanneret is not directed to these features, but rather to a skin-strainer (see column 1, line 45) which is present in all embodiments. Furthermore, while Jeanneret shows the elements cited by the Examiner, their arrangement does not satisfy the requirements to practice the method of claims 3 and 4. There is also no teaching in Jeanneret of the use of a chill or of the incorporation of dissimilar metal inserts into the casting. Thus, it is not felt that there is motivation to combine Jeanneret with either of the other cited references, and

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it is not felt that the combined art teaches, discloses, or suggests the particular arrangement of elements required by the steps of the present invention as set forth in claims 3 and 4. Thus, these claims are felt to provide further distinction over the prior art of record.

With regard to Point 2 of the office action, although there appears to be no need to respond, Applicants' attorney can confirm the Examiner's presumption that the subject matter of the various claims was jointly owned at the time the claimed invention was made.

For the reasons set forth above, it is felt that the claims are clearly distinct over the prior art made of record and that the application is in a condition for allowance. Such allowance is respectfully requested.

Respectfully submitted,
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